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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,659	02/09/2001	Jonathan O. Browne	2676-101	4375

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EXAMINER	
NGUYEN, BINH AN DUC	

ART UNIT	PAPER NUMBER
3713	9

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/778,659	BROWNE ET AL.	
	Examiner	Art Unit	
	Binh-An D. Nguyen	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *15-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed in Paper No. 8, January 29, 2004 has been received. According to the Amendment, claims 1, 12, 15, and 25 have been amended; and claim 31 has been canceled. Currently, claims 1-30 are pending in the application. Acknowledgement has been made.

2. Newly amended claims 15-30 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the system for playing a card game comprising of a plurality of machine readable game cards wherein said card game is accessible to a computer and wherein said card game is played by placing said machine readable game cards on a reader and identify said machine readable game cards with said computer (claim 15) has not been originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Irwin, Jr. et al. (5,471,039).

Irwin, Jr. et al. teaches a system for playing a game, comprising: a machine readable game card; a reader for reading said machine readable game card; a computer connected to said reader; wherein said game is accessible to said computer; wherein said game is played by placing said machine readable game card on said reader and identifying it with said computer; said computer is a mainframe computer (central computer 223); said game is a card game; the machine readable game card comprising: a card with a display surface and a readable surface; at least one path arranged on the readable surface, said path having two terminals; said path having an attribute of a predetermined value measured between said two terminals (7:43-59); an image arranged on the display surface wherein said image being representative of a particular value (electrical signature, 5:6-19); wherein said predetermined value has a one-to-one correspondence with said particular value represented by said image (6:50-7:62); wherein, said path is a conductor, a wave guide, and a transmission line; wherein said predetermined value is a resistance (5:6-9); said display surface and said readable surface are the same surface; said path is formed of conductive ink; said two terminals are formed of conductive ink; said card is formed of paper; said image is formed of a print (Figures 1-37); the reader for reading the machine readable game card comprising a board having a reader; a pair of terminals arranged on said reader; a connector; a

circuit connecting said pair of terminals to said connector for carrying a signal, wherein said signal is associated with said predetermined value; wherein said path terminals on said machine readable game card contact said pair of terminals on said reader when said machine readable game card is placed on said reader, completing said circuit (Figures 17 and 18). See also, columns 1-33.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irwin, Jr. et al. (5,471,039) as applied to claims 1-6, 8-12, 15-17, and 19-27 above, and further in view of Pieterse et al. (6,080,064).

Irwin, Jr. et al. teaches all limitations of claims 1-6 and 8-12. Irwin, Jr. et al. further teaches a method for identifying a game card comprising the steps of: placing the game card in the game card reader, said game card having an image and an attribute of a predetermined value associated with said image; and storing an identification associated with said signal accessible to said computer (30:48-31:63). Irwin, Jr. et al. does not explicitly teach the limitations of: a joystick connector (claim 13). Pieterse et al., however, teaches a system and method for playing a game comprising a joystick connector (Figures 1 and 6); computer comprises a joystick port; connecting a

game card reader to the joystick port; receiving a signal at said joystick port associated with a predetermined value (Figure 6).

Regarding the limitation of a transducer connected to joystick connector, for converting signal to a form suitable for a joystick port (claim 14); and installing a game on a computer having a joystick port, these limitations are notoriously well known in the computer game industry.

Further, regarding the limitation of display surface and readable surface are different surfaces (claim 7), this limitation is a design choice since it does not bring unexpected result.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide Irwin, Jr. et al.'s system for playing a game with a system and method for playing a game having a card reader utilizing joystick connector, as taught by Pieterse et al., to come up with a video game system that enhances the versatility of utilization predetermined values from machine readable cards thus attracts more game players to different types of games using such system and bring forth more profits.

7. Applicant's arguments filed January 29, 2004 have been fully considered but they are not persuasive. Regarding applicant's argument on page 12, third paragraph that Irwin Jr. et al. does not teach a machine readable game card as claimed by the applicant, this is not convincing. Irwin, Jr. et al. does teach a game card comprising at least one path arranged on the readable surface, said path having two terminals; said

path having an attribute of a predetermined value measured between said two terminals (7:43-59), wherein the path (resistor tracks 82-96) formed on the card has an attribute value, e.g., the resistor track 82 can have a resistance of 100KΩ, the resistor track 84 can have a resistance of 300KΩ, etc. (7:43-59).

In response to applicant's argument that there is no suggestion to combine the references (applicant's remark, page 13, third paragraph), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide Irwin, Jr. et al.'s system for playing a game with a system and method for playing a game having a card reader utilizing joystick connector, as taught by Pieterse et al., to come up with a video game system that enhances the versatility of utilization predetermined values from machine readable cards thus attracts more game players to different types of games using such system and bring forth more profits.

Further, applicant arguments regarding the system for playing a card game (applicant's remark, page 12, last paragraph bridging page 13) is mood in view of withdrawal from consideration of claims 15-30, due to elected by original presentation, as presented in paragraph numeral 2 above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

BN

Teresa Walberg
Supervisory Patent Examiner
Group 3700